

REMARKS/ARGUMENTS

Favorable consideration of this application is respectfully requested. Applicant has canceled claims 25-42. Favorable reconsideration of this application is, consequently, earnestly solicited in view of the following remarks.

As to the restriction requirement, Applicant has now canceled claims 25-42, and reserves the right to file a divisional application in the future on these claims.

As to the objection to the Abstract, Applicant has made a good faith attempt to amend the abstract to be of the proper size. Removal of this objection is respectfully requested.

Claims 1, 8 and 9 were rejected under sec. 102e as being anticipated by Kruse '950. The Kruse '950 patent was filed as a utility patent application on December 9, 2002. Applicants application was filed as a utility patent application on August 27, 2003 and claims the benefit of priority to a U.S. Provisional Application Serial No. 60/406,602 filed for on August 28, 2002. Thus, the Kruse '950 reference is NOT available as prior art under sec. 102 since Applicant has the benefit of a priority date well before the filing date of this reference. Thus, removal of this reference is respectfully requested.

Claims 2-7 and 10-24 were rejected under sec. 103 as being unpatentable over Kruse '950. For the same reasons given above, the Kruse '950 reference is not available as prior art against the subject invention. Applicants application was filed as a utility patent application on August 27, 2003 and claims the benefit of priority to a U.S. Provisional Application Serial No. 60/406,602 filed for on August 28, 2002. Thus, the Kruse '950 reference is NOT available as prior art under sec. 102 since Applicant has the benefit of a priority date well before the filing date of this reference. Thus, removal of this reference is respectfully requested.

In addition, applicant strongly disagrees with the examiner's statements that allege all of the claimed features are merely obvious and continuously cites personal feelings without citing references. For example, applicant disagrees with the unsubstantiated allegations that in regard to claim 3 "competing contract development for a proposal...commencing project planning....are common and conventional business

practices.....and obvious”, in regard to claim 4 Kruse can treat a “riser” since it is obvious and its’ obvious “to inspect the piping system so as to ensure dryness and prevent clumping...”, with regard to claim 5 it would have been “obvious” that “remaining residuals are removed by air flushing...”, with regard to claim 6 the claimed “barrier coating” thickness is obvious and using “air to set a resin coating” is obvious, with regard to claim 7 that many “limitations are all expedients....and would be obvious...”, with regard to claims 10-11, treating a “piping system in a multi-story building” is obvious, and ignoring most of the claimed features of these claims, with regard to claims 11-12, all of the claimed “pipe diameters” are obvious, and the claimed thickness is obvious, with regard to claims 13-18 the different types of pipes being treated are obvious, with regard to claim 20 “mapping” is obvious, , with regard to claim 21 “remaining residuals are removed by air flushing...” is obvious, and with regard to claims 22-24, all the claimed features are obvious.

The examiner continuously and erroneously ignores the claimed limitations and instead relies on some type of personal feelings to reject the claims.

It is clearly improper for the examiner to arbitrarily ignore any of the novel features of these claims. Under the rules, if the applicant requests the examiner cite each and every one of the references that supports a rejection, the examiner must cite the reference or remove the rejection. Applicant requests the examiner specifically point out which uncited reference(s) describes and teaches these unsubstantiated opinions and assertions raised in the rejection that all the claimed features of claims 2-7 and 10-24 are obvious under sec. 103. If actual references are not cited and supplied to the applicant to show these unsubstantiated opinions and assertions mentioned in their rejection, the applicant respectfully requests removal of the 103 rejection for at least these reasons alone.

Arguably, it might be “obvious to try” to test different techniques for cleaning and coating inside walls of piping systems. However, the Examiner is well aware that “obvious to try” is not the standard for determining inventiveness. See also *In re Kaplan*, 789 F. 2d at 1580, 229 U.S.P.Q. at 683, where the court held:

“In effect, what the Board did was to use a disclosure of appellants’ own joint invention which had been incorporated in the Kaplan sole disclosure to show that their

invention was but an obvious variation of Kaplan's claimed invention. That amounts to using an applicant's invention disclosure, which is not a 1-year time bar, as prior art against him. That is impermissible."


Additionally, the mere fact that someone in the art can rearrange parts of a reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for someone of ordinary skill in the art, without the benefit of the inventor's specification to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

There is no teaching, nor suggestion for modifying Kruse or any other reference of record to include all the novel features of all the subject claims. Under well recognized rules of the MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant contends the references cannot be modified to incorporate the features of subject claims 1-24 without utilizing Applicant's disclosure. The courts have consistently held that obviousness cannot be established by combining the teachings of the prior art to Applicant to produce the claimed invention, absent some teaching, suggestion, incentive or motivation supporting the combination.

In view of the foregoing considerations, it is respectfully urged that claims 1-24 be allowed. Such action is respectfully requested. If the Examiner believes that an interview would be helpful, the Examiner is requested to contact the attorney at the below listed number.

Respectfully Submitted;



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Date

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